

REMARKS**I. Introduction**

The following issues are outstanding in present Office Action:

- Claims 1-5, 7-14, 16-22, 26-41, 44-50, 52-63 and 66-73 stand rejected under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over U.S. Patent No. 6,237,145 to Narasimhan (hereinafter *Narasimhan*).
- Claims 64 and 65 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Narasimhan*.

Applicant traverses these rejections and requests reconsideration in light of the amendments and remarks contained herein. Claims 1-5, 7-14, 16-22, 26-41, 44-50, 52-63 and 65-73 are pending in this application.

II. Applicant's Record Under § 713.04 of Telephone Interview With Examiner

Applicant respectfully submits the following record of the telephone interview of June 19, 2008, under M.P.E.P. § 713.04. The following persons participated in the interview: Examiner James W. Myhre and Applicant's attorney Kirby B. Drake. The applied reference, *Narasimhan*, was discussed with reference to Applicant's claims. Applicant's attorney and the Examiner discussed the differences between the smart card disclosed in *Narasimhan* and the mobile electronic device set forth in Applicant's claims. Applicant's attorney and the Examiner also discussed other cited but non-applied references made of record by the Examiner. The Examiner indicated that he would consider Applicant's arguments and any amendments made but no agreement was reached as to the allowability of Applicant's claims during this interview.

III. Entry of Amendment After Final

Applicant has amended claims 1, 3, 13, 16, 22, 26, 30, 35, 37, 41, 49, 54, 61-63, 66, 68-70 and 72-73 to further emphasize the mobility of the mobile electronic device in that transmission of data to and from the mobile electronic device is performed wirelessly and/or that the mobile electronic device itself is a wireless device. Support for these amendments may be found at least in paragraphs [0016], [0019], [0021], [0023], [0027], [0030]-[0032] and [0034]-[0040]. Claim 65 also has been amended to correct its dependency in light of the cancellation of claim 64. Accordingly, no new matter has been added by these amendments. It is respectfully asserted that the amendments of these claims are properly enterable amendments after final rejection as the amendments do not present new issues requiring further consideration by the Examiner. Specifically, Applicant has implicitly relied upon this aspect of the claims in response to the previous, non-final Office Action. Moreover, the amended claims should not require a further search of the prior art by the Examiner as the Examiner should have already searched all subject matter which the Examiner reasonably anticipates might be incorporated into Applicant's amendment as directed by M.P.E.P. § 904.02.

IV. Rejections Based on *Narasimhan* Reference

A. Claims 1-5, 7-14, 16-22, 26-41, 44-50, 52-63 and 66-73

Claims 1-5, 7-14, 16-22, 26-41, 44-50, 52-63 and 66-73 stand rejected under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over *Narasimhan*. Applicant traverses this rejection.

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of Cal.*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). “The elements must be arranged as required by the claim....” M.P.E.P. § 2131 citing *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990). “The identical invention must be shown in as complete detail as is contained in the ... claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The Examiner has the burden

of establishing a *prima facie* case of anticipation. See *In re Skinner*, 2 USPQ2d 1788, 1788-89 (B.P.A.I. 1986) (stating, “[i]t is by now well settled that the burden of establishing a *prima facie* case of anticipation resides with the Patent and Trademark Office.”). Applicant respectfully asserts that the rejection does not satisfy these requirements.

To render a claim unpatentable under 35 U.S.C. § 103, all the claim limitations must be taught by the prior art. M.P.E.P. § 2143.03. The Supreme Court stated that “[a] patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art.” *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007). The Supreme Court also acknowledged the importance of identifying “a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does” in an obviousness determination. *Id.* at 1731. The Court indicated that there should be an “explicit” analysis regarding “whether there was an ***apparent reason*** to combine the known elements ***in the fashion claimed*** by the patent at issue.” *Id.* (emphasis added). Further, the Court did not reject the use of the “teaching, suggestion, or motivation” test as a factor in the obviousness analysis, but rather stated that this test may be indicative of non-obviousness under 35 U.S.C. § 103. *Id.* When determining the differences between the prior art and the claims, the question under 35 U.S.C. § 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. M.P.E.P. § 2141.02(I). Applicant respectfully asserts that the rejection does not satisfy these requirements.

1. Independent Claim 1 and Related Dependent Claims

Independent claim 1 recites a method for distributing promotions comprising, in part, “wirelessly transmitting data relating to said promotion to a mobile electronic device of said specific consumer.” *Narasimhan* fails to teach or suggest this limitation. Applicant maintains that the smart card of *Narasimhan* is not a mobile electronic device as set forth in claim 1 as it not capable of wirelessly transmitting or receiving data through a network. Rather, a user of the smart card utilizes a smart card reader/writer to store coupons in a database on the smart card. See, e.g., column 7, lines 23-27. As such, the coupons generated on a user’s computer are transmitted for storage on the smart card only when the smart card is

physically associated with the smart card reader/writer and not through any wireless mechanism. Further, while the Office Action alleges that it would have been obvious to incorporate the functionality of the smart card into other mobile devices (*see, e.g.*, Office Action at 4-5), Applicant respectfully disagrees. While the smart card may be carried around by the user, there is no teaching or suggestion set forth in the reference for incorporation of the smart card into other mobile devices, and thus, the Examiner has not discharged the burden of showing *prima facie* obviousness. Thus, claim 1 should be deemed patentable over the rejection of record.

Further, independent claim 1 recites, in part, “wirelessly applying said promotion to a purchase using said mobile electronic device.” *Narasimhan* fails to teach or suggest this limitation. Again, the smart card of *Narasimhan* is not a mobile electronic device as set forth in claim 1 as the smart card must be physically connected to the merchant device through a smart card reader/writer to allow the merchant device to read the coupons on the smart card. *See, e.g.*, column 7, lines 27-31. As such, a physical connection is required to apply a promotion to a purchase using the smart card of *Narasimhan* and a promotion is not being wirelessly applied using a mobile electronic device. Thus, *Narasimhan* does not teach or suggest this limitation of claim 1.

Claims 2-5 and 7-12 depend directly or indirectly from base claim 1 and thus inherit all limitations of base claim 1. However, each of these claims set forth features and limitations not recited by the references. For example, claim 3 recites “receiving a response from said mobile electronic device of said specific consumer, wherein said response is received wirelessly.” *Narasimhan* does not teach or suggest this limitation as the smart card does not provide a response. Even assuming *arguendo* that the smart card provides a response, it does not do so without being swiped through or inserted into a card reader connected to the merchant device which reads clipped electronic coupons stored on the smart card. *See, e.g.*, column 7, lines 27-31. Thus, any response received from the smart card of *Narasimhan* is not received wirelessly. Similarly, claims 7 and 8 are not taught or suggested by *Narasimhan* as text messages or voice mail messages are not transmitted from a smart card. These messages are now known to be wirelessly transmitted, and data is not pulled from the smart card of *Narasimhan* other than by swiping or inserting the smart card through a card reader. Moreover, the electronic coupon itself is read from the smart card, and thus, no

data is transmitted from the smart card in the form of a text message or voice mail message. Thus, Applicant respectfully asserts that for the above reasons, claims 2-5 and 7-12 are patentable over the rejections of record.

2. Independent Claim 13 and Related Dependent Claims

Independent claim 13 recites, in part, “a method of wirelessly receiving and redeeming promotions via a mobile electronic device.” *Narasimhan* does not teach or suggest this limitation. A user of the smart card disclosed in *Narasimhan* does not wirelessly receive or redeem promotions via the smart card. Rather, the user clips the coupon while sitting at his/her personal computer and stores the coupon in a database on the smart card by employing a smart card reader/writer. *See, e.g.*, column 7, lines 23-27. Further, the user redeems a coupon stored on the smart card by swiping or inserting the smart card through a smart card reader/writer attached to the merchant device. *See, e.g.*, column 6; lines 52-55; column 7, lines 27-31. The smart card therefore is tethered to the reader/writer in order for promotions to be read from or stored onto the smart card. Thus, independent claim 13 should be deemed patentable over the rejection of record.

Further, claim 13 recites, in part, “accessing, with said mobile electronic device, data, relating to said promotion, wirelessly transmitted to said mobile electronic device from a server.” *Narasimhan* fails to teach or suggest this limitation. Again, no data relating to a promotion is wirelessly transmitted to the smart card from a server. Rather, the user clips the coupon while sitting at his/her personal computer and stores the coupon in a database on the smart card by inserting or swiping the smart card into a smart card reader/writer. *See, e.g.*, column 7, lines 23-27. Accordingly, the user’s personal computer receives the data from the server, not the smart card. As such, claim 13 is patentable over the rejection of record.

Independent claim 13 also recites, in part, “redeeming said promotion by wirelessly replying to said server using said mobile electronic device.” *Narasimhan* fails to teach or suggest this limitation. The smart card of *Narasimhan* does not include any mechanism (i.e., input means or the like) to allow a user of a smart card to wirelessly reply to a server using the smart card. Rather, the smart card is swiped or inserted into a smart card reader/writer so as to permit a promotion to be redeemed, and it is the merchant device or the user’s personal

computer depending on the stage when the promotion is to be redeemed, and not the smart card, that communicates with the server to redeem a promotion. *See, e.g.*, column 6, lines 52-57; column 7, lines 27-31. Thus, claim 13 is patentable over the rejection of record.

Claims 14 and 16-21 depend directly or indirectly from base claim 13 and thus inherit all limitations of base claim 13. However, each of these claims set forth features and limitations not recited by these references. For example, claim 16 recites that “said consumer wirelessly requests said promotion from said server by using said mobile electronic device.” *Narasimhan* fails to teach or suggest this limitation again because the smart card does not include any mechanism (i.e., input means or the like) to allow a user of a smart card to wirelessly request a promotion from a server. Rather, any communication that the user of the smart card has with a server occurs via action by the merchant device or the user’s personal computer, not the smart card. *See, e.g.*, column 6, lines 30-36 and 52-57; column 7, lines 27-31. Further, claim 21 recites “wherein said redeeming is by telephone, text message, or multi-media message.” *Narasimhan* fails to teach or suggest this limitation. While the Examiner is correct that promotional information set forth in *Narasimhan* may be textual, graphic, video or audio information (*see* Office Action at 10 referencing column 3, lines 28-35 of *Narasimhan*), nowhere does *Narasimhan* teach or suggest that a promotion may be redeemed by telephone, text message or multi-media message. Text messages or voice mail messages are not transmitted from a smart card. These messages are now known to be wirelessly transmitted, and data is not pulled from the smart card of *Narasimhan* other than by swiping or inserting the smart card through a card reader. Moreover, the electronic coupon itself is read from the smart card, and thus, no data is transmitted from the smart card in the form of a text message or voice mail message. Thus, Applicant respectfully asserts that for the above reasons, claims 14 and 16-21 are patentable over the rejection of record.

3. Independent Claim 22

Independent claim 22 recites a method for distributing a promotion comprising, in part, “sending promotion data to a consumer web portal account wirelessly accessible on a mobile electronic device of said consumer.” *Narasimhan* fails to teach or suggest this limitation. Promotion data is not wirelessly accessible on the smart card of *Narasimhan*. Rather, the smart card must be physically associated with a smart card reader/writer in order

for promotion data to be stored on or retrieved from the smart card. *See, e.g.*, column 7, lines 23-27. Moreover, *Narasimhan* does not teach or suggest that a consumer web portal account is wirelessly accessible on a smart card. Even assuming *arguendo* that a consumer web portal account is disclosed in *Narasimhan*, it is the user's personal computer that accesses a server containing a web portal account, not the smart card. *See, e.g.*, column 4, lines 9-20. Thus, claim 22 should be deemed patentable over the rejection of record.

Further, independent claim 22 recites, in part, "saving said promotion in a promotion saving account accessible by said mobile electronic device wherein said consumer wirelessly redeems said promotion using said mobile electronic device for a purchase at a point of sale (POS)." *Narasimhan* fails to teach or suggest this limitation. Again, the smart card of *Narasimhan* does not meet the limitations of a mobile electronic device as set forth in claim 22 as the smart card must be physically connected to the merchant device through a smart card reader/writer to allow the merchant device to read the coupons on the smart card. *See, e.g.*, column 7, lines 27-31. A user of the smart card disclosed in *Narasimhan* swipes or inserts the smart card into a smart card reader/writer connected to the merchant device so that the merchant device may access the coupons stored on the smart card. The merchant device then redeems the promotion *See, e.g.*, column 7, lines 27-31. As such, this limitation is not taught or suggested by *Narasimhan*.

4. Independent Claim 26 and Related Dependent Claims

Independent claim 26 recites, in part, "a method for wirelessly distributing a promotion to a mobile electronic device." *Narasimhan* does not teach or suggest this limitation. A promotion is not wirelessly distributed to the smart card disclosed in *Narasimhan*. Rather, the user accesses the promotion via his/her personal computer, and the promotion is stored on the smart card by physically associating the smart card with a smart card reader/writer attached to the personal computer. *See, e.g.*, column 7, lines 23-27. Thus, the promotion is not being wirelessly distributed to the smart card. As such, this limitation of claim 26 has not been met.

Claim 26 further recites "wirelessly transmitting data relating to said promotion to said mobile electronic device of said consumer." *Narasimhan* does not teach or suggest this

limitation. Again, data relating to a promotion is not wirelessly transmitted to the smart card disclosed in *Narasimhan*. Rather, the user accesses the promotion via his/her personal computer, and the promotion is stored on the smart card by physically associating the smart card with a smart card reader/writer attached to the personal computer. *See, e.g.*, column 7, lines 23-27. Thus, a physical connection is needed between the smart card reader/writer and the smart card, and even so, the data is transmitted to the user's personal computer, not to the smart card. As such, claim 26 should be deemed patentable over the rejection of record.

Claims 27-29 depend directly or indirectly from base claim 26 and thus inherit all limitations of base claim 26. However, each of these claims set forth features and limitations not recited by these references. Thus, Applicant respectfully asserts that for the above reasons, claims 27-29 are patentable over the rejection of record.

5. Independent Claim 30 and Related Dependent Claims

Independent claim 30 recites, in part, "a method of wirelessly distributing a promotion to a mobile electronic device." *Narasimhan* does not teach or suggest this limitation. A promotion is not wirelessly distributed to the smart card disclosed in *Narasimhan*. Rather, the user accesses the promotion via his/her personal computer, and the promotion is stored on the smart card by physically associating the smart card with a smart card reader/writer attached to the personal computer. *See, e.g.*, column 7, lines 23-27. Thus, the promotion is not being wirelessly distributed to the smart card. As such, this limitation of claim 30 has not been met.

Claim 30 further recites "wirelessly transmitting data relating to said promotion to said mobile electronic device of said consumer." *Narasimhan* does not teach or suggest this limitation. Again, data relating to a promotion is not wirelessly transmitted to the smart card disclosed in *Narasimhan*. Rather, the user accesses the promotion via his/her personal computer, and the promotion is stored on the smart card by physically associating the smart card with a smart card reader/writer attached to the personal computer. *See, e.g.*, column 7, lines 23-27. Thus, a physical connection is needed between the smart card reader/writer and the smart card, and even so, the data is transmitted to the user's personal computer, not to the smart card. As such, claim 30 should be deemed patentable over the rejection of record.

Claims 31-36 depend directly or indirectly from base claim 30 and thus inherit all limitations of base claim 30. However, each of these claims set forth features and limitations not recited by these references. For example, claim 35 recites that the requesting consumer contacts the distributor via his/her mobile electronic device by calling a telephone number, sending an email message, or sending a text message. A user cannot use the smart card of *Narasimhan* to contact the distributor by calling a phone number, sending an email message or sending a text message, and there are no input means on the smart card making it feasible to do so. Similarly, claim 33 recites that “said requesting consumer contacts a distributor to request said promotion using said mobile electronic device.” *Narasimhan* does not teach or suggest this limitation as the user of a smart card does not contact a distributor to request a promotion using the smart card. Rather, the user communicates with the distributor, using, for example, his/her personal computer. When the promotion is later received, it is only then saved onto the smart card, and there are no input means on the smart card making it feasible to do so. *See, e.g.*, column 6, lines 30-36; column 7, lines 23-27. Thus, Applicant respectfully asserts that for the above reasons, claims 31-36 are patentable over the rejection of record.

6. Independent Claim 37 and Related Dependent Claims

Independent claim 37 recites a method for distributing a promotional offer to a targeted consumer comprising, in part, “wirelessly transmitting said offer to a mobile electronic device of said targeted consumer, wherein said targeted consumer is selected from a plurality of potential consumers.” *Narasimhan* fails to teach or suggest this limitation. Specifically, an offer is not wirelessly transmitted to the smart card disclosed in *Narasimhan*. Rather, the offer is transmitted to the user’s personal computer. Only when the electronic coupon associated with the offer is later received by the personal computer is the electronic coupon then saved onto the smart card. *See, e.g.*, column 6, lines 30-36; column 7, lines 23-27. Thus, this limitation of claim 37 has not been met.

Independent claim 37 further recites “receiving a reply from said mobile electronic device of said targeted consumer in response to said promotional offer.” *Narasimhan* also fails to teach or suggest this limitation. The smart card of *Narasimhan* does not reply to a promotional offer. Rather, the user considers the promotional offer by reviewing the offer on

his/her personal computer. If the offer is later accepted, the user will receive an electronic coupon that is then saved onto the smart card. *See, e.g.*, column 6, lines 30-36; column 7, lines 23-27. Accordingly, the user of the system set forth in *Narasimhan* makes a decision as to whether to reply to a promotional offer using his/her personal computer and not the smart card. Further, there are no input means provided on the smart card to permit a user to reply to an offer using said smart card. Accordingly, Applicant respectfully asserts that claim 37 is patentable over the rejection of record.

Claims 38-40 depend directly or indirectly from base claim 37 and thus inherit all limitations of base claim 37. However, each of these claims set forth features and limitations not recited by these references. Thus, Applicant respectfully asserts that for the above reasons, claims 38-40 are patentable over the rejection of record.

7. Independent Claim 41 and Related Dependent Claims

Independent claim 41 recites a system for distributing and redeeming a promotion comprising, in part, “a mobile electronic device operable for wirelessly transmitting a request for promotional data and for wirelessly receiving generated promotion data.” *Narasimhan* fails to teach or suggest this limitation. As previously discussed, the smart card of *Narasimhan* does not wirelessly transmit a request for promotional data or wirelessly receive generated promotion data. Rather, the user requests and reviews promotions presented on his/her personal computer (*see, e.g.*, column 3, lines 9-16). When the user wishes to take advantage of a promotion, he/she requests a coupon associated with the promotion (*see, e.g.*, column 6, lines 30-36) which may then be saved to the smart card which is physically associated with the personal computer via a smart card reader/writer (*see, e.g.*, column 7, lines 23-27). Accordingly, the smart card of *Narasimhan* neither wirelessly transmits a request for promotional data nor does it wirelessly receive generated promotional data. As such, this limitation of claim 41 has not been met.

Claims 44-48 depend directly or indirectly from base claim 41 and thus inherit all limitations of base claim 41. However, each of these claims set forth features and limitations not recited by these references. Thus, Applicant respectfully asserts that for the above reasons, claims 44-48 are patentable over the rejection of record.

8. Independent Claim 49 and Related Dependent Claims

Independent claim 49 recites a method for consumer contact comprising, in part, “transmitting, to a mobile electronic device of a consumer, data relating to a promotion, wherein said promotion is generated from the profile of said consumer.” *Narasimhan* fails to teach or suggest this limitation. As previously discussed, data relating to a promotion is not transmitted to the smart card disclosed in *Narasimhan*. Rather, the user in *Narasimhan* reviews data relating to a promotion on his/her personal computer (*see, e.g.*, column 3, lines 9-16). When the user wishes to take advantage of a promotion, he/she requests a coupon associated with the promotion (*see, e.g.*, column 6, lines 30-36) and it is that coupon which may be saved to the smart card which has been physically associated with the personal computer via a smart card reader/writer (*see, e.g.*, column 7, lines 23-27). Thus, no data relating to a promotion is being transmitted to the smart card of *Narasimhan*. Accordingly, claim 49 should be deemed patentable over the rejection of record.

Claim 49 further recites “matching said promotion with a merchant profile in a merchant profile database when said consumer redeems said promotion by wirelessly communicating using said mobile electronic device in an electronic purchase.” *Narasimhan* fails to teach or suggest this limitation. A user does not redeem a promotion by wirelessly communicating using the smart card of *Narasimhan*. Rather, a user of the system set forth in *Narasimhan* redeems the promotion on his/her personal computer (*see, e.g.*, column 3, lines 9-16) by requesting a coupon associated with the promotion (*see, e.g.*, column 6, lines 30-36). That coupon is then saved to the smart card which has been physically associated with the personal computer via a smart card reader/writer (*see, e.g.*, column 7, lines 23-27). Even assuming *arguendo* a promotion may be saved on the smart card, a promotion still is not wirelessly redeemed with the smart card. Rather, the smart card is again physically associated with a smart card reader/writer, and the promotion would be extracted and redeemed via actions of the smart card reader/writer and/or the merchant device, not the smart card. Thus, a user of the smart card disclosed in *Narasimhan* is not redeeming a promotion by wirelessly communicating using the smart card in an electronic purchase. Accordingly, this limitation of claim 49 has not been met.

Claims 50 and 52-54 depend directly or indirectly from base claim 49 and thus inherit all limitations of base claim 49. However, each of these claims set forth features and limitations not recited by these references. For example, claim 54, as amended, recites “receiving by said processor consumer requests for promotions transmitted from said mobile electronic device of said consumer.” *Narasimhan* does not teach or suggest this limitation. Requests for promotions are not transmitted to a processor by the smart card of *Narasimhan*. Rather, requests for promotions are sent from the user’s personal computer. Thus, Applicant respectfully asserts that for the above reasons, claims 50 and 52-54 are patentable over the rejection of record.

9. Independent Claim 55 and Related Dependent Claims

Independent claim 55 is directed to a mobile electronic device comprising, in part, “means for requesting data regarding a promotion from a remote server” and “means for receiving said data from said remote server.” Applicant respectfully asserts that *Narasimhan* fails to teach or suggest these limitations. The Office Action acknowledges that the user in *Narasimhan* “requests the promotional data by logging in and walking through the hierarchical tree to select the desired promotional data (coupons) which are then stored in the database on the smart card.” *See* Office Action at 16. Accordingly, the user uses his/her personal computer to request data regarding a promotion from a remote server and does not use the smart card to make such a request. *See, e.g.*, column 3, lines 9-16; column 6, lines 30-36. The server sends a coupon to the user’s personal computer, and the user saves that coupon to the smart card which has been physically associated with the personal computer via a smart card reader/writer (*see, e.g.*, column 7, lines 23-27). Accordingly, the smart card of *Narasimhan* does not receive data regarding a promotion from a remote server; rather, the smart card receives a coupon from the user’s personal computer. Thus, these limitations of claim 55 have not been met.

Claims 56-60 depend directly or indirectly from base claim 55 and thus inherit all limitations of base claim 55. However, each of these claims set forth features and limitations not recited by these references. For example, *Narasimhan* does not teach that the mobile electronic device is “a mobile telephone and the unique identification is the telephone number” as set forth in claim 58. The Office Action alleges that *Narasimhan* discloses

utilizing an Internet or telephone interface. *See* Office Action at 11-12. However, *Narasimhan* addresses use of these interfaces to describe how the server may be connected to the user's personal computer, and not the form that the smart card may assume. Further, *Narasimhan* fails to teach or suggest a mobile electronic device that may perform all of the limitations of claim 55 and take the form of a mobile telephone. Thus, Applicant respectfully asserts that for the above reasons, claims 56-60 are patentable over the rejection of record.

10. Independent Claim 61 and Related Dependent Claims

Independent claim 61 has been amended to incorporate the subject matter of dependent claim 64. Accordingly, claim 64 has been canceled. Claim 61 recites a system for redeeming promotions comprising, in part, "a wireless mobile electronic device associated with a particular consumer." *Narasimhan* fails to teach or suggest this limitation. The smart card of *Narasimhan* is not a wireless mobile electronic device. Rather, the smart card must be physically associated with the user's personal computer or with the merchant device by swiping or inserting it into a smart card reader/writer. *See, e.g.*, column 7, lines 20-31. As such, the smart card does not operate as a wireless mobile electronic device.

Further, claim 61 recites "means for receiving from said wireless mobile electronic device associated with said particular consumer an acceptance of said promotion." *Narasimhan* fails to teach or suggest this limitation. Even assuming *arguendo* that the smart card of *Narasimhan* is a wireless mobile electronic device, the smart card does not contain any mechanism to wirelessly transmit acceptance of a promotion from the smart card. *See, e.g.*, column 7, lines 10-31. Thus, this limitation of claim 61 has not been met.

Claims 62 and 63 depend directly or indirectly from base claim 61 and thus inherit all limitations of base claim 61. However, each of these claims set forth features and limitations not recited by the references. For example, claim 63 recites "means operable in response to communications from said wireless mobile electronic device for coordinating payment for said associated transaction." *Narasimhan* fails to teach or suggest this limitation. The smart card of *Narasimhan* does not send communications for the system to respond to for coordinating payment for an associated transaction. Rather, the smart card of *Narasimhan* merely acts as a traditional credit or debit card for payment purposes. *See, e.g.*, column 7,

lines 50-59. Thus, Applicant respectfully asserts that for the above reasons, claims 62 and 63 are patentable over the rejection of record.

11. Independent Claim 66 and Related Dependent Claims

Independent claim 66 recites a system for coordinating transactions comprising, in part, “means for coordinating said received information from a wireless mobile electronic device of a specific one of said users with information available to said server pertaining to said unique merchant location.” *Narasimhan* fails to teach or suggest this limitation. The smart card of *Narasimhan* is not a wireless mobile electronic device. Further, the system in *Narasimhan* does not receive information specific to one of many merchants directly from the smart card. Rather, a smart card reader/writer must be connected to the merchant device and the smart card swiped or inserted into the smart card reader/writer to allow the merchant device to communicate to the server information about, for example, the POS location of the merchant. *See, e.g.*, column 7, lines 27-37. Thus, information is not received from the smart card and coordinated with information available to said server pertaining to said unique merchant location. Accordingly, this limitation of claim 66 has not been met.

Claim 66 further recites “means for communicating at least a portion of said coordinated information to said wireless mobile electronic device of said one user over said temporarily established connection, said coordinated information including promotional information associated with said specific user.” *Narasimhan* fails to teach or suggest this limitation. The system of *Narasimhan* does not include means to communicate coordinated information including promotional information associated with the specific user to the smart card. Rather, promotional information is saved onto the smart card which is physically associated with the user’s personal computer through a smart card reader/writer when the user receives the promotional information on his/her personal computer. *See, e.g.*, column 6, lines 30-57; column 7, lines 10-31. Accordingly, independent claim 66 should be deemed patentable over the rejection of record.

Claims 67-69, although indicated as rejected in the Office Action Summary, are not specifically addressed within the body of the Office Action. Accordingly, Applicant respectfully points out that the rejection of these claims does not comport with Office policy.

Specifically, the Examiner is directed that “[i]n accordance with the patent statute, ‘Whenever, on examination, any claim for a patent is rejected , or any objection . . . made’, notification of the reasons for rejection and/or objection together with such information and references as may be useful in judging the propriety of continuing the prosecution (35 U.S.C. 132) should be given.” M.P.E.P. § 707. As such the Examiner has not “clearly articulate[d] any rejection early in the prosecution process so that the applicant has the opportunity to provide evidence of patentability and otherwise respond completely at the earliest opportunity.” M.P.E.P. § 706. Applicant therefore requests that the Examiner set forth the grounds for rejection with respect to claims 67-69 in order that Applicant may have a full and fair opportunity to explore the patentability of this claim.

Regardless, claims 67-69 depend directly or indirectly from base claim 66 and thus inherit all limitations of base claim 66. Each of these claims set forth features and limitations not recited by these references. For example, claim 68 recites “means at said server for accepting further information from said wireless mobile electronic device of said one user, said further information comprising acceptance information for both said cost information and said promotion information.” *Narasimhan* fails to teach or suggest this limitation as the smart card does not send further information including acceptance information to means at the server. Rather, the merchant device communicates information such as acceptance information to the server. *See, e.g.*, column 7, lines 32-37. Similarly, claim 69 recites “means at said server for coordinating payment to said one merchant from said one user, said payment based upon said information communicated to said wireless mobile electronic device of said user and said acceptance information from said wireless mobile electronic device of said user. However, *Narasimhan* fails to teach or suggest this limitation as payment is not coordinated based on information sent from the smart card to the server but rather based on information transmitted from the merchant device. *See, e.g.*, column 7, lines 32-37. Thus, Applicant respectfully asserts that for the above reasons, claims 67-69 are patentable over the rejection of record.

12. Independent Claim 70 and Related Dependent Claims

Independent claim 70 recites a method for coordinating transactions comprising, in part, “coordinating said received information from said wireless mobile electronic device

specific one of said users with available information pertaining to said unique merchant location.” *Narasimhan* fails to teach or suggest this limitation. The smart card of *Narasimhan* is not a wireless mobile electronic device. Further, the system in *Narasimhan* does not receive information specific to one of many merchants directly from the smart card. Rather, a smart card reader/writer must be connected to the merchant device to allow the merchant device to communicate to the server information about, for example, the POS location of the merchant. *See, e.g.*, column 7, lines 27-37. Thus, information is not received from the smart card and coordinated with information available to said server pertaining to said unique merchant location. Thus, this limitation of claim 70 has not been met.

Independent claim 70 further recites “communicating at least a portion of said coordinated information to said wireless mobile electronic device of said one user over said temporarily established connection, said coordinated information including promotions available to said specific one of said users pertaining to said obtained merchandise.” *Narasimhan* fails to teach or suggest this limitation. The system of *Narasimhan* does not communicate coordinated information including promotional information associated with the specific user to the smart card. Rather, promotional information is saved onto the smart card which is physically associated with the user’s personal computer through a smart card reader/writer when the user receives the promotional information on his/her personal computer. *See, e.g.*, column 6, lines 30-57; column 7, lines 10-31. Accordingly, independent claim 70 should be deemed patentable over the rejection of record.

Claims 71-73 although indicated as rejected in the Office Action Summary, are not specifically addressed within the body of the Office Action. Accordingly, Applicant respectfully points out that the rejection of these claims does not comport with Office policy. Specifically, the Examiner is directed that “[i]n accordance with the patent statute, ‘Whenever, on examination, any claim for a patent is rejected , or any objection . . . made’, notification of the reasons for rejection and/or objection together with such information and references as may be useful in judging the propriety of continuing the prosecution (35 U.S.C. 132) should be given.” M.P.E.P. § 707. As such the Examiner has not “clearly articulate[d] any rejection early in the prosecution process so that the applicant has the opportunity to provide evidence of patentability and otherwise respond completely at the earliest opportunity.” M.P.E.P. § 706. Applicant therefore requests that the Examiner set forth the

grounds for rejection with respect to claims 71-73 in order that Applicant may have a full and fair opportunity to explore the patentability of this claim.

Regardless, claims 71-73 depend directly or indirectly from base claim 70 and thus inherit all limitations of base claim 70. Each of these claims set forth features and limitations not recited by these references. For example, claim 72 recites “accepting further information from said wireless mobile electronic device of said one user, said further information comprising acceptance information for said cost information and for said promotion.” *Narasimhan* fails to teach or suggest this limitation as the smart card does not send further information including acceptance information to the system. Rather, the merchant device communicates any information to the server. *See, e.g.*, column 7, lines 32-37. Similarly, claim 73 recites “coordinating payment to said one merchant from said one user, said payment based upon said information communicated to said wireless mobile electronic device of said user and said acceptance information from said wireless mobile electronic device of said user, including acceptance or rejection of said promotion.” However, *Narasimhan* fails to teach or suggest this limitation as payment is not coordinated based on information sent from the smart card to the server but rather based on information transmitted from the merchant device. *See, e.g.*, column 7, lines 32-37. Thus, Applicant respectfully asserts that for the above reasons, claims 71-73 are patentable over the rejection of record.

B. Claims 64 and 65

Claims 64 and 65 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Narasimhan*. Applicant traverses this rejection. Claim 64 has been canceled as the subject matter of this dependent claim has been incorporated into independent claim 61. Claim 65 depends directly or indirectly from base claim 61 and thus inherits all limitations of base claim 61. However, this claims sets forth features and limitations not recited by these references. For example, claim 65 recites a system “wherein said wireless mobile electronic device is a cell phone.” While the Examiner is correct that promotional information set forth in *Narasimhan* may be textual, graphic, video or audio information (*see* Office Action at 10 referencing column 3, lines 28-35 of *Narasimhan*), nowhere does *Narasimhan* teach or suggest that the wireless mobile electronic device is a cell phone. Moreover, there is no teaching or suggestion that the smart card of *Narasimhan* could be replaced with a cell phone.

While the Office Action references two ways for allegedly entering and retrieving data from smart cards, such as the one disclosed in *Narasimhan*, (*see* Office Action at 12), there is no disclosure that these ways for entering and retrieving data via a mobile electronic device were even contemplated by *Narasimhan*. Thus, Applicant respectfully asserts that for the above reasons, claim 65 is patentable over the rejection of record.

V. The Cited But Non-Applied References

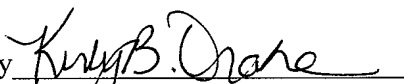
Applicant has reviewed the references cited but not applied by the Examiner, and Applicant submits that Applicant's pending claims, particularly considered in view Applicant's proposed claim amendments, should be deemed allowable over all of these references.

VI. Conclusion

In view of the above, Applicant believes the pending application is in condition for allowance. Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 06-2380, under Order No. 65003/P002US/10312242 from which the undersigned is authorized to draw.

Dated: June 23, 2008

Respectfully submitted,

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